

REMARKS

The Examiner's disallowance of applicant's claim for domestic priority is respectfully traversed. The Examiner states, *inter alia*:

“---However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-35 of this application. Specifically, provisional application 60/275,631 does not provide support for the independent claim limitation that the multi-functional alcohol is "present in a ratio to said vegetable oil such that there are at least 0.7 moles of OH groups per mole of bulk vegetable oil." Additionally, there are numerous dependent claim limitations that are not supported (e. g., specific compositional components and the amounts thereof)---”(emphasis added).

The Examiner's attention is directed to the disclosure of the examples at pages 8-10 of the specification of the provisional application wherein support for the limitations in question may be found.

Thus, in Example 1 it is disclosed that there are 30 lbs. of multifunctional alcohol and 399 lbs. of soy-based oil present in the reaction mixture. In Example 2, it is stated that there are 30.8 lbs. of multifunctional alcohol and 110 lbs. of soy-based oil present. It is respectfully submitted that these ratios, both being above the minimum ratio required in the present claims and the lower ratio being substantially close thereto, adequately support the claim limitation. The same is true with respect to the other ratios and reactant proportions and parameters set forth in the claims.

If the Examiner is requiring that the specification of the provisional application “support” the claim limitations by using precisely the same language, it is respectfully submitted that the patent law with regard to support for claim limitations in the specification is otherwise. For example, see *In re Blaser*, 194 USPQ 122 wherein the federal court stated:

“---Appellants rely on the rationale of *In re Wertheim*, supra, as " 'clearly applicable here.' Appellants urge that if a disclosure of 25-60% solids content taught those

skilled in the art that 35-60% was part of the invention in *Wertheim*, although the latter range was not expressly mentioned therein, then appellants' disclosure of 60⁰ C to 200⁰ C in SN 159,159 would likewise teach 80⁰ C to 200⁰ C as part of appellants' invention. We agree with appellants that *Wertheim* is controlling on this point. We further note that in SN 159,159 appellants disclosed initially mixing the starting materials at a temperature up to 80⁰ C prior to heating the reaction blend thus obtained to a maximum temperature of 200⁰ C. We conclude that SN 159,159 adequately supports the limitation "80⁰ C to 200⁰ C" as recited in claims 7-12---".

The controlling decision in this area of the law, as stated in *Blaser* is that in *In re Wertheim*, 191 USPQ 90, wherein the predecessor to the CAFC held as follows:

"--- Fact that applicants' foreign application describe the invention as employing a colloids contents within 25-60% range along with specific embodiments of 36% and 50% warrant a conclusion, in context of process for making freeze-dried instant coffee from concentrated coffee, that persons skilled in art would consider claimed process employing 35-60% solids content range to be part of invention; Patent and Trademark Office's mere argument of lack of literal support is not enough; In *re Lukach*, 169 USPQ 795, statement that invention claimed does not have to be described in *ipsis verbis* in order to satisfy 35 U.S.C. 112 description requirement would be empty verbiage if lack of literal support alone were enough to support 35 U.S.C. 112 rejection; burden of showing that claimed invention is not described in specification rests on Patent and Trademark Office in first instance, and it is up to it to give reasons why description not in *ipsis verbis* is insufficient.

Therefore, the law in this area is clear: the specification need not *ipsis verbis* recite claim language in order to provide support therefore. It is sufficient that the specification make it clear that the applicant had possession of the invention defined in the claim at the time of filing the application whose support is sought.

Thus, in the present case, since the examples set forth in the specification of the provisional application recite proportions, ratios and parameters well within the ranges set forth in the specification, the specification is adequately supportive thereof notwithstanding that the exact same language is not used therein. See *Wertheim* and *Blaser, supra*.

It is respectfully submitted therefore, that the present claims are entitled to the priority date of the provisional application, which predates the effective date of each references relied upon by the Examiner to reject the claims.

Claims 1-16, 18, 19, 22, 26-29, and 32 were rejected under 35 U.S.C. § 102(e) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as being unpatentable over Kurth, U.S. Published Patent Application 2002/0090488 (Kurth '488).

The rejection is respectfully traversed because the Kurth '488 reference is not prior art with respect to the present application. The specification of the present application, as amended, includes a claim to the benefit of the filing date of U.S. Provisional Application No. 60/275,631, filed March 15, 2001. Note that the Declaration and Power of Attorney filed on June 03, 2002, in this application specifically included a claim to the benefit under 35 U.S.C. § 119(e) of U.S. Provisional Application No. 60/275,631. The March 15, 2001 filing date of the provisional application is prior to the October 10, 2001 filing date of the Kurth '488 reference. Accordingly, Kurth '488 is not a valid reference under 35 U.S.C. § 102(e) or 35 U.S.C. § 103(a). Note that, although the Kurth '488 reference claims the benefit of parent applications, it is a continuation-in-part application, and, consequently, it is not evident on the face of the reference that the disclosures therein are entitled to any effective date earlier than the filing date of the Kurth '488 reference itself. Accordingly, rejection of this application as unpatentable over the Kurth '488 reference is inappropriate, and the Examiner is respectfully requested to withdraw it.

Claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the Kurth '488 reference. Because the Kurth '488 Published Application is not a valid reference, as pointed out above, this rejection is not appropriate, and the Examiner is respectfully requested to withdraw it.

Claims 20, 21, 24, 25, 30, 31, 34, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kurth '488 in view of Smith et al., U.S. Patent 6,060,145. As discussed above, Kurth '488, the primary reference, is not a valid reference. Accordingly,

the rejection over Kurth '488 in combination with Smith is not appropriate, and the Examiner is respectfully requested to withdraw it.

Claims 23 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kurth '488 in view of Scott et al., U.S. Published Application No. 2003/0114062. As discussed above, Kurth '488, the primary reference, is not a valid reference. Accordingly, the rejection over Kurth '488 in combination with Scott is not appropriate, and the Examiner is respectfully requested to withdraw it.

Claim 12 is objected to as being a substantial duplicate of Claim 4. The objection is respectfully traversed. The claims are of substantially different scope in view of the different transitional phrases used therein. Claim 4 recites that the catalyst "is" a tertiary amine, Claim 12 recites that the catalyst "comprises" a tertiary amine. Accordingly, there is no basis for objecting to Claim 12 as being a substantial duplicate of Claim 4, and the Examiner is respectfully requested to withdraw the objection.

The amendment to correct the evident typographical error in Claim 26 makes it clear that "dangling limitation" at the top of page 23 (between Claims 26 and 27) is properly a part of Claim 26. Accordingly, the basis for the objection in Paragraph 1 of the Office Action has been removed by this amendment.

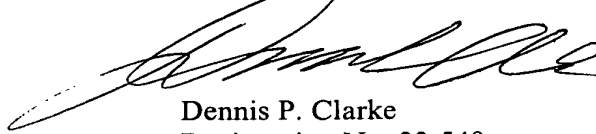
Claims 1, 13-25, 26, and 30-35 are provisionally rejected under the judicially created doctrine of double patenting over certain claims of copending Application No. 10/097,439. Applicants will address these rejections, including the possible filing of appropriate terminal disclaimers, when there is indication of allowable matter in the application.

In view of the above amendments and discussion, the applied references do not provide a valid basis for rejecting the currently pending claims.

Applicant has earnestly endeavored to place the condition for allowance and an early action toward that end is respectfully requested.

Respectfully submitted,

Miles & Stockbridge P.C.

A handwritten signature in black ink, appearing to read "Dennis P. Clarke", is written over the printed name.

Dennis P. Clarke
Registration No. 22,549

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1751 Pinnacle Drive
Suite 500
McLean, VA 22102-3833
Tel: (703) 903-9000
Fax: (703) 610-8686

Customer No. 000181